

REMARKS

The examiner objects to the specification.

The examiner objects to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention as specified in the claims.

The application includes claims 1-12 and 15-22 prior to entering this amendment.

The examiner rejects claims 20-21 under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

The examiner rejects claims 20-21 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner rejects claims 1-4, 10-12, and 15-22 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. (U.S. Patent 6,877,863) in view of Haile-Mariam (U.S. Patent Application Publication 2001/0000300).

The examiner rejects claims 5-9 under 35 U.S.C. § 103(a) as being unpatentable over Wood et al. in view of Dister et al. (U.S. Patent 6,298,735) and Haile-Mariam.

The applicant traverses all rejections. The applicant amends claims 21. The application remains with claims 1-12 and 15-22 after this amendment.

The applicant adds no new matter and requests reconsideration.

Drawing Objections

The drawings stand objected to by the Examiner because the figures do not show all of the features recited in the claims. The applicant amends Figure 3A to include element 234 (motors), consistent with the specification as filed at, e.g., page 4, lines 13-18, as amended above. The applicant removes the element "electronics in the projector" from claim 21 and so this element is no longer required to be shown in the drawings. Therefore, the applicant requests that the Examiner withdraw the drawing objections.

Specification Objection

The Examiner indicates on page 1 of the Office Action Summary that the specification is objected to. However, no indication has been provided by the Examiner as to what portions of

the specification are objected to, or for what reasons. Consequently, the applicant requests that the specification objection be withdrawn.

Claim Rejections - 35 U.S.C. § 112, first paragraph

The Examiner proposes that claim 20 does not comply with 35 U.S.C. § 112, first paragraph, because the claim recites “**at least one** motor” and the specification does not “state the exact numbers of motors” or “show any evidence that the apparatus is able to function a large number of motors.” See Office Action paragraph 4. However, the applicant submits that neither of these is a requirement under 35 U.S.C. § 112, first paragraph.

MPEP 2164.01(b) states:

As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970). Failure to disclose other methods by which the claimed invention may be made does not render a claim invalid under 35 U.S.C. 112. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533, 3 USPQ2d 1737, 1743 (Fed. Cir.), *cert. denied*, 484 U.S. 954 (1987).

The application as filed states at page 4, lines 13-18:

In an embodiment, the support 201 might include motors, e.g., step motors, coupled to the base 227 and the platform 219 to automatically move the projector 203 vertically and horizontally. The step motors might be actuated using a variety of well-known actuation devices, e.g., buttons 233. The projector's electronics can read the motor steps (in the case of using step motors) to discern the rotation angle and to, ultimately, more accurately semi automatically correct for keystone distortion.

Since the application as filed specifically refers to the use of motors, and claim 20 recites ‘at least one motor’, the applicant submits that claim 20 complies with 35 U.S.C. § 112, first paragraph. As stated in the MPEP, the applicant does not need to state the exact number of motors or show evidence that a large number of motors could be used because these are “other methods by which the claimed invention may be made”, and therefore their absence “does not render a claim invalid under 35 U.S.C. § 112.” See MPEP 2164.01(b). Consequently, the applicant requests that the Examiner withdraw the 35 U.S.C. § 112, first paragraph, rejection of claim 20.

Regarding the 35 U.S.C. § 112, first paragraph, rejection of claim 21, the applicant removes the element “electronics in the projector” from the claim and submits that the claim as amended complies with 35 U.S.C. § 112, first paragraph.

Claim Rejections - 35 U.S.C. § 112, second paragraph

The Examiner proposes that claim 20 fails to comply with 35 U.S.C. § 112, second paragraph, for the exact same reasons it is proposed not to comply with 35 U.S.C. § 112, first paragraph. However, MPEP 2172(I) states “[a] rejection based on the failure to satisfy this requirement is appropriate only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims.” The Examiner has not provided any indication of where the applicant has stated that the system defined by claim 1 (from which claim 20 depends) can not include at least one motor. Further, the applicant would like to direct the Examiner’s attention to the thousands of issued patents containing the limitation “at least one” of an element, which enjoy a presumption of validity and therefore compliance with 35 U.S.C. § 112, second paragraph. Consequently, the applicant requests that the Examiner withdraw the 35 U.S.C. § 112, second paragraph, rejection of claim 20.

Regarding the 35 U.S.C. § 112, second paragraph, rejection of claim 21, the applicant removes the element “electronics in the projector” from the claim and submits that the claim as amended complies with 35 U.S.C. § 112, second paragraph.

Claim Rejections - 35 U.S.C. § 103

Regarding claims 1, 5, and 10, each of the claims refers to a projector being *attached* to a support. The Examiner acknowledges that Wood does not teach a support, but then proposes that this feature is taught in Haile. However, Haile does not teach that its projector 1 is attached to the projector tray 8. Haile seems to teach exactly the opposite because it teaches that the projector can be easily removed from the mechanical arm and that the projector’s adjustable front foot can be used for horizontal adjustment on the projector tray. *See* Haile paragraphs [0057] and [0063]. Consequently, the projector tray of Haile is not equivalent to the support recited in the claims and thus, does not make up for the deficiency of Wood. Therefore, claims

1, 5, 10, and their dependent claims are allowable over the combination of Wood and Haile, and the applicant requests allowance.

Further regarding claim 17, the Examiner relies on the 'equivalents substituted for the same purpose' rationale and proposes that the moving platform and base of Haile is equivalent to the curved wall and at least one channel recited in claim 17. However, MPEP 2144.06 specifically states that "[i]n order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents." The Examiner has not provided any indication of how the moving platform and base of Haile and the "curved wall and at least one channel" of claim 17 are recognized in the prior art as equivalents. The Examiner points to paragraph [0067] of Haile for support, but this paragraph does not teach that a curved wall and at least one channel is equivalent to its moving platform and base. The Examiner also cites *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963) as supporting this rejection, but the applicant would like to point out that in *Scott*, a simple change of materials in the core of a shaft was found not to be obvious under this rationale. Far from being a simple change of materials, claim 21 recites a completely different structure from the moving platform and base of Haile. Consequently, the applicant submits that claim 17 is allowable over the combination of Wood and Haile, at least because the combination does not teach or suggest all of the features recited in the claim.

Further regarding claim 20, the Examiner has taken Official Notice that it is well known in the art to use a motor in a support. The Official Notice suggests that incorporating a motor into a support is well known in the art, but claim 20 specifically refers to a projector attached to a support and the support having a motor. Even if incorporating a motor into a support were well known in the art, despite the fact that the Examiner has not provided any support for this proposition, this would still not meet the claimed features because the claim refers to a projector attached to a support including a motor. In other words, the Official Notice taken by the Examiner does not address the features recited in the claim. Consequently, the Applicant submits that the Official Notice in combination with Wood and Haile does not teach or suggest the features of claim 20.

Also, in order to achieve the desired combination, the Examiner uses Wood for the projector, Haile for the support, and the Official Notice for the motor. The applicant would like

to point out that the entire disclosure of Haile refers to movement of its apparatus by hand (see e.g., paragraphs [0034] and [0067]-[0070]) and if it was well known in the art to use a motor in the support, one would expect Haile to at least have mentioned that a motor could be used to move its projector tray. However, Haile contains no such teachings.

Finally, MPEP 2144.03(A) states “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” The applicant submits that combining a motor with a projector support is not capable of ‘instant and unquestionable demonstration’. The applicant would also like to point out that MPEP 2144.03(A) indicates that Official Notice should only be taken in Final Office Actions in “rare” circumstances. Consequently, in accordance with MPEP 2144.03(C), the applicant requests that the Examiner provide documentary evidence to support the Official Notice.

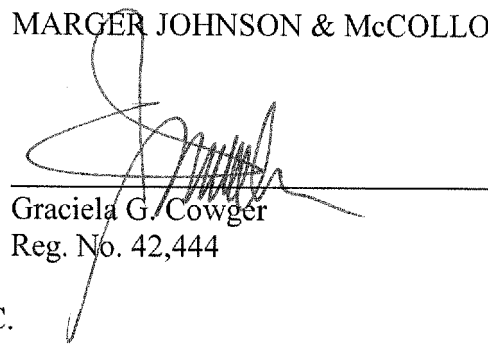
Conclusion

For the foregoing reasons, reconsideration and allowance of claims 1-12 and 15-22 of the application as amended is requested. The examiner is encouraged to telephone the undersigned at (503) 222-3613 if it appears that an interview would be helpful in advancing the case.

Customer No. 20575

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.



Graciela G. Cowger
Reg. No. 42,444

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
503-222-3613

APPENDIX

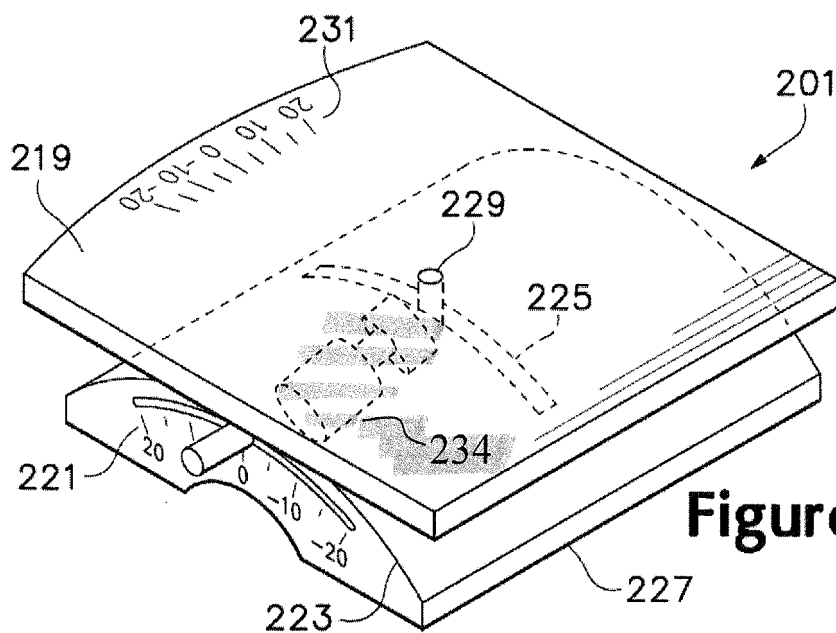


Figure 3A

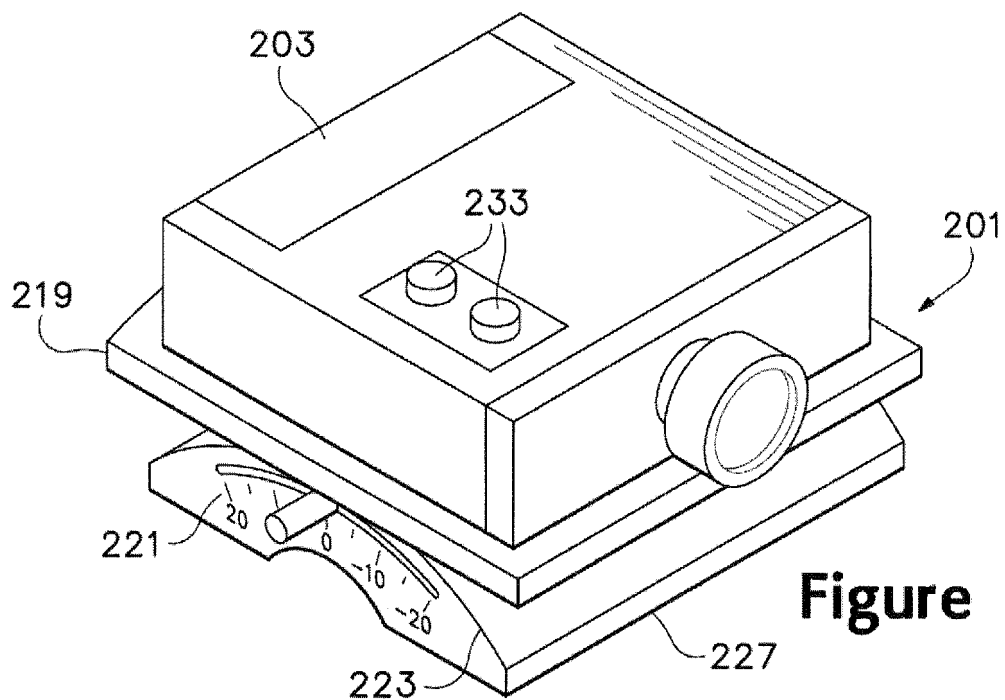


Figure 3B